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08/060,653 05/13/93 HOGE

D 1411-0210000
EXAMINER

KORZUCH, W

ART UNIT PAPER NUMBER

6

BSM1/0928
STERNE, KESSLER, GOLDSTEIN & FOX
1225 CONNECTICUT AVE., NW
WASHINGTON, DC 20036

2512
DATE MAILED:

09/28/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 7/7/94 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-12 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-12 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle. 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Claim Rejections - 35 USC § 112

1. Claims 2-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2, 6 and 10, line 2, "Panasonic Model D350" is vague to the structure of the helical deck and indefinite since the model may change over time.

In claim 5, lines 10, 14, 15 and 17-18, "Storage Technology Corporation Model 4400" and "4400 automated cartridge system" are vague to the structure of the automated cartridge system and indefinite since the model may change over time.

In claim 9, lines 2, 6, 7 and 16, "3480-style cartridge" is vague to the structure of the cartridge and indefinite since the model may change over time.

Claim Rejections - 35 USC § 103

2. Claims 1-4 and 9-12 are rejected under 35 U.S.C. § 103 as being unpatentable over Shimizu et al in view of Godsoe et al and further in view of Applicant's admitted prior art as shown on page 11, lines 18-27 for the reasons set forth in the Office action dated March 7, 1994.

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3. Claims 5-8 are rejected under 35 U.S.C. § 103 as being unpatentable over Shimizu et al in view of Godsoe et al and Applicant's admitted prior art as shown on page 11, lines 18-27 and further in view of Moy et al for the reasons set forth in the Office action dated March 7, 1994.

Response to Amendment

4. Applicant's arguments filed on July 7, 1994 have been fully considered but they are not deemed to be persuasive.

Applicant asserts on page 3, "the Specification memorializes the structure of the D350 helical deck by explicitly incorporating by reference a detailed technical discussion of the D350 and therefore the structure is clear and definite". It is the Examiner's position that Panasonic controls the structure of the D350 helical deck and Panasonic may change the structure at any time. Therefore, the structure of the D350 helical deck is unclear and indefinite. The Examiner further maintains this position with respect to the 4400 automated cartridge system and the 3480-style cartridge.

Applicant further asserts on page 4, "the use of trademarks and names used in trade are permissible in patent applications if their meanings are established by an accompanying definition which is sufficiently precise and defined or their meanings are well known and satisfactorily defined in literature." It is the

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Examiner's position that products defined by model numbers are not trademarks nor are they names used in trade.

Applicant further asserts on pages 6 and 7, that "elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents." The Examiner maintains that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). Furthermore, it should be noted that the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference, In re Bosek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969), and that every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, 193 USPQ 12 (CCPA 1977).

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS

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ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Korzuch whose telephone number is (703) 308-1296.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

William R. Korzuch

William R. Korzuch

September 21, 1994

Stuart S. Levy
STUART S. LEVY
SUPERVISORY PATENT EXAMINER
GROUP 2500